



Image AF/36438

THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application Serial No. 09/636,731)	Group Art Unit: 3643
Filing Date: August 10, 2000)	Examiner: Rowan, Kurt C.
For: Chest Fly Box System)	Docket No.: 013174.0101PTUS (Formerly 9283/001)
Inventor: Jerry Moore)	Confirmation No.: 9120
)	Paper No.: 21

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence, along with all papers referred to as being enclosed or attached, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

February 12, 2004
Date

Elaine C. Von Spreckelsen
Elaine C. VonSpreckelsen

MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Sir:

APPELLANT'S APPEAL BRIEF

Appellant herewith files his Brief in support of his Appeal in the above-identified matter.

This Appeal Brief is timely filed pursuant to 37 C.F.R. §1.192 because it is filed within three months of December 10, 2003, which is the date on which Appellant filed his Notice of Appeal, and a request and fee for a one-month extension of time are enclosed.

Appellant hereby authorizes the Commissioner to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR §1.136(a) for its timely submission, as incorporating a petition for extension of the appropriate length of time, and to charge any additional costs for such extension to Deposit Account No. 50-1848.

Serial No. 09/636,731
Appeal Brief
Page 1
192585v2

02/19/2004 MBIZUNES 00000099 501848 09636731
01 FC:2402 165.00 DA

1.) REAL PARTY IN INTEREST

The real party of interest is the inventor, Jerry Moore. A product covered by the claims is currently being sold by Flyte Deck, Inc., a Colorado corporation wholly owned by Mr. Moore.

2.) RELATED APPEALS AND INTERFERENCES

None.

3.) STATUS OF CLAIMS

Claims 1 – 21, 23 – 25, 40, and 41 are pending on appeal. Claims 19 – 21 are withdrawn from consideration. Claims 1 – 6, 23 – 25, 40, and 41 stand rejected under 35 U.S.C. 103(a). Claims 7 – 18 are objected to as being dependent on a rejected base claim, but are indicated to be allowable if rewritten in independent form.

The history of the claim amendments is as follows. Claims 1 – 39 were filed in the initial application. On November 21, 2001, Appellant canceled claims 22 and 26 – 39 in response to a restriction requirement dated October 23, 2001. At the same time, claims 19 – 21 were withdrawn from consideration as a non-elected species. These claims will be reinstated if a generic claim is found to be patentable. In an amendment filed March 26, 2002 in response to an Office Action dated December 26, 2001, claims 1 and 25 were amended. These claims were further amended in an amendment filed June 17, 2002 in response to an Office Action dated May 6, 2002, and again amended in an amendment filed with an RCE on August 6, 2002 in response to an Office Action dated June 28, 2002. In an amendment filed February 6, 2003 in response to an Office Action dated November 6, 2002, Appellant again amended claims 1 and 25, as well as amended claims 23 and 24, and added new claims 40 and 41. In an amendment filed with a second RCE on July 22, 2003 in response to an Office Action dated April 23, 2003, Appellant further amended claims 1 and 25 and also amended claim 3. On December 10, 2003, Appellant made a final non-substantive amendment to claims 1 and 25 in a response to 35 USC §112 rejections in an Office Action dated September 10, 2003. A formal amendment to claims

23 and 24 to correct an antecedent/dependency problem discovered while preparing the Appeal Brief is submitted with this brief.

4.) STATUS OF AMENDMENTS

The Examiner has not provided an Advisory Action indicating that the amendment filed on December 10, 2003 with the Notice of Appeal will be entered. Of course, the amendment filed with this Appeal Brief has not been entered. However, since all the amendments address informalities, and since the amendment filed on December 10, 2003 are straightforward responses to 35 CFR §112 rejections while the amendment filed with this Appeal Brief are obvious corrections of an antecedent/ dependency problem, we will assume that these amendments will be entered. The Appendix includes copies of the claims with and without the 35 CFR §112 amendments.

5.) SUMMARY OF THE INVENTION

The invention is a chest fly box system 100. A chest fly box is a fly box used by fly fishermen. It is attached to the fisherman with a harness so that it rests on the center of the chest. See Exhibit A attached to the response faxed to the USPTO on February 6, 2003 (hereinafter "Exhibit A"). A chest fly box generally has a thin dimension and two relatively longer dimensions. In its stored position, it lies flat against the chest, with its thin dimension extending out from the chest just a few inches. This position prevents the fly box from getting wet as the fly fisherman wades into a stream or lake, and also prevents it from interfering with the fly fishing casting motion. See Exhibit A and page 1, lines 31 – 32¹. The chest fly box of the prior art includes at least one tray or other storage compartment that can be rotated ninety degrees down from the chest so it extends horizontally outward from the chest and is accessible. See Exhibit A and page 1, line 32 – page 2, line 8.

¹ Page and line numbers in this Appeal Brief refer to the specification of the present application, unless indicated otherwise.

Typically, a fly fisherman will adjust his or her lures, flies, and/or hooks to accommodate a wide variety of fish and fishing conditions. This may occur many times a day depending on changing fish feeding conditions, the type of fish, etc. In prior art chest fly boxes, this required a complicated, cumbersome process of changing trays. In addition, a fisherman with a chest fly box was restricted to trays made by the manufacturer of the particular fly box. See page 2, line 9 through page 3, line 5. The chest fly box system 100 according to the invention includes: a pocket-sized fly box 400 (FIGS. 1, 4, and 8; page 3, line 28; page 7, lines 21 – 25; page 12, lines 14 – 20; claim 1, lines 1 – 3); a base piece 202 for supporting the pocket-sized fly box (FIG. 2; page 3, line 28; page 7, line 24; page 8, line 27 – page 9, line 14; claim 1, line 3); a harness 300 that secures the base piece 202 to the chest of a fisherman, with the base piece 202 resting on the front of the chest (FIGS. 1 and 3; page 3, lines 28 and 29; page 11, line 22 – page 12, line 14; page 13, line 30 – page 14, line 8; claim 1, lines 4 and 5); and a hinge 322, 324 for permitting movement of the fly box 400 from a horizontal to a vertical position (FIGS. 8 and 9; page 6, lines 13 and 27; page 12, lines 23 – 25; page 13, lines 14 – 17; page 14, lines 27 – 29; page 15, lines 3 – 5; claim 1, lines 6 and 7). The chest fly box system 100 also includes a fastener 322a, 324a, 322b, 324b adapted to releasably secure the fly box 400 to the base piece 202 so the inside of the fly box can be accessed without removing the fly box from the base piece; the fastener is adapted so that the fly box 400 can be removed from the base piece 202 without using a tool. (See FIGS. 3, 4, 8, and 9; page 3, lines 29 and 30; page 4, lines 5 – 10; page 6, lines 23 – 27; page 13, lines 1 – 23; page 14, line 24 – page 15, line 6; claim 1, lines 8 – 12). This system 100 allows the fly fisherman to quickly and easily change his lures, flies, hooks, etc., while still keeping the fly box 400 secure and dry during fishing under the trying conditions often faced by fly fishermen, and retaining the other advantages of a chest fly box system. It also permits a variety of different fly boxes 400 to be used with the system 100. See page 13, lines 1 – 23.

The invention also includes a fishing rod holder 204 which is contiguous to the base piece 202 and is configured to hold a fishing rod 610 in a horizontal orientation under the pocket-sized fly box 400. See FIGS. 1, 2, 8, and 9; page 4, lines 11 – 23; page 7, lines 25

– 27; page 9, line 15 – page 10, line 17; and claim 3. This allows the fishing rod 610 to be secured in a position and location where it will not interfere with operations such as tying a fly and unhooking a fish. It also prevents it from catching on overhanging tree branches. The fishing rod holder 204 preferably comprises a U-shaped trough 240. *Ibid.*, particularly page 4, line 17; page 9, lines 25 and 26; claim 23. The fishing rod holder 204 is integrally formed with the fly box support 202, the two made of a single piece of rigid material. See FIG. 2; page 4, lines 20 – 30; page 5, lines 7 – 9; page 10, lines 10 – 14; claim 25, lines 3 and 4. The base piece 202 includes a fly box support plate 208. The support plate 208 and the upper edges 248 and 252 of the trough 240 are in a horizontal plane, so that they cooperate to provide support to the fly box 400 when it is in the opened, horizontal position. See FIGS. 2 and 9; page 5, lines 2 – 7; page 10, lines 5 – 10.

6.) ISSUES

The issues on appeal are:

1. Whether claims 1, 2, 4, and 40 are obvious under 35 U.S.C. 103(a) based on Wimler (US 1,549,400) in view of Gillespie (US 4,831,772).
2. Whether claims 1 and 2 are obvious under 35 U.S.C. 103(a) based on Volmer (US 5,950,352).
3. Whether claims 3, 5, 6, 23 – 25, and 41 are obvious under 35 USC 103 (b) based on Wimler in view of Gillespie and Hutton (US 5,505,354).

7.) GROUPING OF CLAIMS

Group I consists of claims 1, 2, and 40.

Group II consists of claim 4 and 5. These claims are separately patentable from the claims of the other groups because they include the limitation that the base piece includes a horizontal support plate.

Group III consists of claims 3, 6, and 24. These claims are separately patentable from the claims of the other groups because they include the limitation of a fishing rod holder contiguous to said base piece and configured to hold a fishing rod in a horizontal

orientation under a pocket-sized fly box supported on said base piece.

Group IV consists of claim 23. This claim is separately patentable from the claims of the other groups because it includes the limitation that the fishing rod holder comprises a U-shaped trough.

Group V consists of claims 25 and 41. These claims are separately patentable from the claims of the other groups because in combination with the base piece, fastener, and hinge as recited in claim 1, they include the following limitations: an integrated fly box support and a fishing rod holder made of a single piece of rigid material, and the fishing rod holder configured to hold a fishing rod in a horizontal orientation while the inside of the fly box is being accessed.

Group VI consists of claims 7 – 18. These claims are separately patentable from the claims of the other groups because they have been indicated to be allowable by the Examiner if rewritten in independent form.

8.) ARGUMENT

I. INTRODUCTION

As defined in 37 CFR 1.192, subparagraphs 8(iii) and 8(v) are not relevant to the instant appeal and are therefore omitted. Since they have all been overcome by responsive amendments, and the only other Examiner's rejections were under 35 USC §112 first and second paragraphs and 35 U.S.C. §103, the entire argument herein relates to subparagraphs 8(i), 8(ii) and 8(iv) of 37 CFR 1.192. In this argument, we shall reply to the Office Action of September 10, 2003 (hereinafter "the Office Action"), since this Office Action states all the currently outstanding rejections in this application.

II. THE 35 U.S.C. §102 REJECTIONS OF THE EXAMINER

In the Office Action of September 10, 2003, the Examiner made two 35 U.S.C. §112 rejections. To eliminate the §112 issues and make the appeal simpler, each of these rejections were responded to by an appropriate amendment. The rejections and how they

are believed to be overcome are as follows.

Claims 1 – 18, 23, and 24 were rejected because claim 1 had the limitation that the base piece covered less than 50% of the chest in a normal adult human, which the Examiner believed was not described in the specification. This was not believed to be correct because such a base piece is shown in the drawings and the dimensions of the base piece are given in the specification. However, this limitation has been removed from claim 1 by amendment.

Claims 1 – 18, 23 – 25, 40, and 41 were rejected because the limitation “the inside of the fly box” in claim 1, line 10, and “the inside” in claim 25, line 5, had insufficient antecedent basis. The proper antecedent, i.e., a fly box “having an inside” has been provided in line 3 of claim 1 by amendment. In claim 25, it was necessary to move the limitation of the fastener to a position prior to the limitation of the fishing rod holder to provide the proper antecedent, i.e., “having an inside” after “the fly box”, so this has been done by amendment.

As mentioned above, when the Appeal Brief was being prepared, it was noted that claims 23 and 24 improperly depended on claim 1 which had no antecedent for “said fishing rod holder”. They have been amended to properly depend on claim 3, which includes the antecedent for “said fishing rod holder,” in an amendment filed with this Appeal Brief.

III. THE CITED PRIOR ART

A. United States Patent No. 1,549,400 Issued To Wimler

Wimler discloses a “fisherman’s cabinet” which is shown attached to the waist of a fisherman using a pair of straps 7 (FIGS. 1 and 2). The cabinet includes a bottom portion 9 and a cover or base portion 6 which is the portion attached to the fisherman’s waist. The bottom portion is attached to the cover portion with a hinge, which is not numbered but is shown as a small round cylinder at the bottom center of FIG. 4. See column 1, lines 34 – 40. The bottom portion is open-ended, and contains compartments 14, 15 for holding fishing items. See column 2, lines 59 – 70. When open, the bottom portion 9 is horizontal.

Stops 19 (FIG. 4) near the hinge or the bottom corners 20 (FIG. 2) of the cover limit downward movement of the bottom portion. See column 2, lines 79 – 89. The bottom portion can be moved from a horizontal to a vertical position via the hinge. When it is moved vertically, it is held in the vertical closed position with a hasp 8 which fits over loop 11. See column 1, line 29 – column 2, line 58. A pair of bait boxes 16 (FIGS. 1 – 4) are pivotally supported on opposite sides of the bottom portion 9 of the cabinet. See column 2, lines 71 – 79.

B. United States Patent No. 4,831,772 Issued To Gillespie

Gillespie discloses a fishing tackle box 12 that includes a large number of smaller containers 56 for holding individual items of fishing tackle. The tackle box 12 has various strips of Velcro™ 42 (FIGS. 1 and 3) and 82 (FIG. 4) attached to the bottom (FIG. 1), sides (FIG. 4), and to divider plates 44 (FIG. 3), referred to as a “first attachment means”. Each of the containers 56 also has attached strips of Velcro™ 86 (FIG. 5) referred to as a “second attachment means”. The Velcro™ holds the containers 56 in place in the tackle box to prevent them from moving or shifting. See column 5, lines 47 – 68.

Of particular relevance to the present invention is a modified individual container 56a (FIG. 6), which has a line slot 90 through which a line 92 can pass. This allows the fisherman to attach the lure to the line 92 without handling the lure so the fisherman is not exposed to the hooks. See column 4, lines 22 – 55. This container can be removably attached to a fishing rod (FIG. 8) using a third strip of Velcro™ 102 attached to the fishing rod, allowing the fisherman to detach and attach the line without being exposed to the lure hooks, and providing a convenient place to store the container 56a while fishing. See column 6, lines 19 – 44.

C. United States Patent No. 5,505,354 Issued To Hutton

Hutton discloses a fishing tackle box 100 designed to be attached to the fisherman's belt 302, 304. See column 5, lines 26 – 28. The preferred size of the tackle box 100 is 8 inches in length by 3.5 inches in width by 3 inches deep. See column 3, lines 31 – 33. The pertinence to the present invention is the fact that the box 100 has a fishing rod bracket 142 attached to the exterior surface of the box. See column 4, lines 8 – 11.

D. United States Patent No. 5,950,352 Issued To Volmer

Volmer discloses a fishing wallet 86 (FIG. 9) which can be hung around the user's neck and held against the user's chest. The wallet has Velcro™ strips 92 which are used to hold interchangeable plates 84 (FIGS. 5 and 6) which have pockets 94 for holding fly boxes 54. See column 8, lines 54 – 58. The wallet 86 also includes pockets 120 for holding leader line. See column 10, lines 22 – 25. The wallet can be folded along line 112, which the Examiner refers to as a hinge. See column 11, lines 32 – 36.

IV. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP I

A. The Examiner's rejection of claims 1, 2, and 40 under 35 U.S.C. §103(a) based on Wimler and Gillespie is not proper because the combination of Wimler and Gillespie would require a substantial reconstruction and design of the elements shown in the references, as well as a change in the basic principals of Wimler.

The facts of this portion of the appeal are on all fours with *In re Ratti*, 123 USPQ 349 (CCPA 1959). In *Ratti*, the Board took note of the common knowledge that resilient deformable materials are incompressible. Here, the Board can take note of the fact that the releasable fastener as shown in Gillespie would not work in Wimler without significant reconstruction. Appendix B attached hereto shows the combination of Wimler and Gillespie, with as little reconstruction as possible. In this sketch, the thickness of the hook and loop fastener is exaggerated with respect to the other parts to make it easier to discuss. To make this combination, some sort of hinge plate is required to be connected to the hinge so as to provide room for the Velcro™ to attach. This is already a modification that is not proper, but for sake of argument, we will continue. Wimler is an all-purpose tackle box that is designed to hold a wide variety of tackle, plus a couple of bait boxes. It is much heavier than the containers of Gillespie. Also, in the position that the containers are connected to the fishing line in Gillespie, essentially all the hook and loop fasteners of the Velcro™ strip will be equally supporting the container. However, in Wimler, the tackle box is required to extend outward from the cover plate a considerable distance. The leverage of the box in this position would put significantly more stress on the hook and loop fastener

“A” at the top of the VelcroTM strip. This would cause the hook and loop “A” to separate, putting more stress on hook and loop fastener “B”, which would in turn separate, putting more stress on hook and loop fastener “C”. As a result, the box bottom would pull away from the hinge plate and fall off. Most people have experienced such a failure of a hook and loop fastener, and anyone familiar with hook and loop fasteners would know this, and thus the Board can take note of it as the CCPA did in *Ratti*. See *Ratti*, at page 351, headnote 1.

The fact that the hood and loop fasteners of Gillespie would not support the tackle box of Wimler would be clear to anyone skilled in the art; thus, they would not combine Wimler and Gillespie.

One could overcome the above problem by, in addition to the hinge plate, putting support under the fly box bottom, using a VelcroTM design that supported the box in two directions, making the tackle box of Wimler significantly smaller and lighter, and eliminating the bait boxes of Wimler². These changes not only result in wholesale modification of the references, but also change the principal of operation of Wimler, since it is no longer an all-purpose tackle box. Thus, this combination is not a proper ground for rejection of the claims. See *Ratti*, p. 352, at headnote 2. These changes are not suggested in the references, but rather in the present application. Thus, no prima facie case of obviousness of claim 1 under 35 U.S.C. § 103(a) has been made by the Examiner. See MPEP 2142 and 2143.01. Since claims 2 and 40 depend on claim 1, they are also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

B. The Examiner's rejection of claims 1 and 2 under 35 U.S.C. §103(a) based on Volmer is not proper because two key limitations of claim 1 are missing from Volmer.

2 The Examiner may argue that all these modifications are not shown in claim 1, and/or that they must be included in claim 1 as they are essential to the invention. That would not be correct because the combination recited in claim 1 has utility as claimed. In *Ratti*, all the modifications that were part of the invention were not together in a single claim, but various ones of the modifications were claimed separately in claims 1, 4, 7, and 10. See *Ratti*, page 351, column 2. The *Ratti* court held that once the appellant had taught how the combination could be done, others could make redesigns. See *Ratti*, page 352, second paragraph following footnote 2. This is the case here also. For example, the Appellant has designed a system that meets claim 1, but uses a snap swivel instead of VelcroTM, and does not use a fishing rod holder to add support for the fly box.

On page 6 of the Office Action, the Examiner rejects claims 1 and 2 under 35 U.S.C. 103(a) because allegedly, "The patent to Volmer shows a chest fly box as shown in FIG. 9 which shows a base piece, a harness, a hinge 112, and a fastener 92."³ Claim 1 recites:

A chest fly box system for holding fishing equipment, comprising:
a base piece for supporting a pocket-sized fly box having an inside;
a harness that secures said base piece to the chest of a fisherman,
with said base piece resting on the front of said chest;
a hinge for permitting movement of said fly box from a horizontal to a
vertical position; and
a fastener adapted to releasably secure said pocket-sized fly box to
said base piece so said inside of said fly box can be accessed without
removing said fly box from said base piece;
wherein said fastener is adapted so that said fly box can be removed
from said base piece without using a tool.

Referring to the above claims and FIGS. 5, 6, and 9 of Volmer, the Examiner does not say whether he considers that pockets 120 in FIG. 9 or the fly boxes 54 in FIGS. 5 and 6. If it is the fly box, Volmer lacks an important limitation of the invention, that the fly boxes can be accessed without removing them from the base piece. In addition, the hinge 112 does not permit movement of the fly box from a horizontal to a vertical position, since the fly boxes in FIGS. 5 and 6 are always in the vertical position. Thus, the Volmer system does not exhibit the key useful advantage of providing access to the fly box while standing in a stream and at the same time allowing two hands free to grasp the fly and attach it to a line. Instead, the user has to use one hand to hold the fly box as he is accessing it, put the fly box away, and then attach the fly to the line. If the user changes his mind, he will have to repeat the action of removing the fly box, accessing it, and putting it back.

If the pocket 120 is the "fly box", then Volmer does not disclose either a fastener adapted to releasably secure said pocket-sized fly box to said base piece, nor does it show a fastener that is adapted so that said fly box can be removed from said base piece without

³ On page 6 of the Office Action, the Examiner suggests that the 35 U.S.C. 103(a) rejection is being made rather than a 35 U.S.C. 102 rejection because Volmer does not show that "the base piece covers less than 50% of the chest of in a normal adult human being". The foregoing limitation in quotation marks has been removed from the claim because it was rejected under 35 U.S.C. §112, and all §112 rejections have been overcome by amendments so as to simplify the issues on appeal. However, since all limitations in a claim are required to be identically disclosed in a reference for a §102 rejection, the argument herein also applies if this is converted to a §102 rejection.

using a tool. Again, a key advantage of the instant invention is not available, namely, that the fly box can be quickly interchanged with other fly boxes.

It is fundamental patent law that to establish a prima facie basis for obviousness, all claim limitations must be taught or suggested by the prior art. MPEP 2143.03. "It is error to ignore specific limitations distinguishing over the references." *In re Glass*, 176 USPQ 489, 491 (CCPA 1973). See also *In re Saether*, 181 USPQ 36, 39 (CCPA 1974) at headnote 1; *Ex parte Petersen*, 228 USPQ 217, 218 (PO Bd Pat App & Inter 1985) at headnote 1; and *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 3. Since in either interpretation of claim 1 two key limitations of the claim are missing in Volmer, Volmer cannot make the invention obvious. Since claim 2 depends on claim 1, it is also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

V. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP II

The Examiner's rejection of claims 4 and 5 under 35 U.S.C. §103(a) based on Wimler in view of Gillespie and Hutton is not proper for the reasons given in Section IV because the combination of Wimler and Gillespie does not include a key limitation of claim 4.

Claim 4 is patentable because it depends on claim 1. In addition, claim 4 includes the following limitations:

said base piece comprises a vertical chest plate and a horizontal support plate, said vertical chest plate and said horizontal support plate forming a right angle, said chest plate having an upper edge, a lower edge, a chest-side surface and an outside surface, said support plate having an inner edge, an outer edge, a first side edge and a second side edge, a top surface, a bottom surface, a support plate width, and a support plate length, said inner edge contiguous with said lower edge of said chest plate, said support plate width and said support plate length being adequate to support a pocket-sized fly box in its vertical closed position.

In rejecting this claim, the Examiner says: "In reference to claim 4, Wimler shows all of the dimensions recited." That's all. He does not point out where the horizontal support plate is in Wimler, nor how such a support plate supposedly meets any of the limitations.

Serial No. 09/636,731

Appeal Brief

Page 12

192585v2

This horizontal support plate is useful because it interacts with the fly box, fishing rod holder, and the fasteners to hold the fly box securely without undue stress on the fasteners. There is no horizontal support plate in Wimler nor Gillespie. Thus, since an important limitation of claim 4 is missing, Wimler and Gillespie cannot make claim 4 obvious. MPEP 2143.03. *In re Glass*, supra; *In re Saether*, supra; *Ex parte Petersen*, supra; and *In re Fine*, supra. Since claim 5 depends on claim 4, it is also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

VI. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP III

The Examiner's rejection of claims 3, 6, and 24 under 35 U.S.C. §103(a) based on Wimler in view of Gillespie and Hutton is not proper because the combination of Wimler, Gillespie, and Hutton does not include three key limitations of claim 3.

Claims 3, 6, and 24 are patentable for the reasons given in Section IV above because they depend on claim 1. In addition, they are also patentable because they contain the limitation of a fishing rod holder contiguous to the base piece and configured to hold a fishing rod in a horizontal orientation under a pocket-sized fly box supported on the base piece. The Examiner admits that Wimler and Gillespie do not show a fishing rod holder, but maintains that Hutton “shows a fishing rod holder 142 mounted on the fly box support 102 and being configured to hold the fishing rod in a horizontal position”. The Examiner does not even allege that the fishing rod holder 142 in Hutton holds the fishing rod under the pocket-sized fly box as claimed. In addition, the fishing rod holder of Hutton is not attached to a “fly box support” as alleged by the Examiner, nor does the fishing rod holder hold the fishing rod in a horizontal position. We will address these in reverse order.

The Examiner maintains that the bracket 142 of Hutton holds a fishing rod in a horizontal position. This is impossible. The tackle box housing 102 of Hutton is preferably 8 inches long and attached to a fisherman's waist. See the above summary of Hutton. Hutton does not explain how the bracket 142 is used to hold a fishing rod. If the rod is placed horizontally on the bracket 142, it will either pass through the fisherman's body, which is ridiculous, or it will fall off because it will project far out from the fisherman's body

and be unbalanced. Further, the small size of the bracket suggests that it is not contemplated that the rod will be balanced on it. Rather, the only way this bracket could hold a fishing rod is if it pivoted about its connection to the tackle box. It is likely that it does pivot; otherwise, it would stick out inconveniently from the tackle box. If it were raised and a fishing rod handle were placed through its loop, the weight of the fishing rod would make the bracket rotate downward and force the fishing rod handle against the side of the tackle box, holding it with friction. Thus, it is likely that the rod holder of Hutton holds the fishing rod in a vertical direction. In this direction, it would brush on overhanging trees along a stream and not be very useful to a fly fisherman. At any rate, it is clear that Hutton does not disclose that the bracket 142 can be used to hold a fishing rod in a horizontal direction. Thus, this limitation is missing from the combination of Hutton, Wimler, and Gillespie.

Claim 1 from which claim 3 depends, as well as the specification, make clear that the base piece (which the Examiner calls the “fly box support”) recited in claim 3 is not the same as the fly box. The closest things to a fly box support in Hutton are the loops 302, 304 (FIG. 3) which attach the tackle box to the belt. These loops are not contiguous to the fishing rod holder 142.

Finally, as mentioned above, the Examiner does not even allege that the fishing rod holder 142 in Hutton holds the fishing rod under the pocket-sized fly box as claimed. This is important because it places the fishing rod in a position where it does not interfere with tying a fly on to the line.

Thus, the combination of Wimler, Gillespie, and Hutton do not disclose three limitations of claim 3, and therefore claim 3 is patentable. MPEP 2143.03; *In re Glass*, supra; *In re Saether*, supra; *Ex parte Petersen*, supra; and *In re Fine*, supra. Since claims 6 and 24 depend on claim 3, they are also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

VII. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP IV

The Examiner's rejection of claim 23 under 35 U.S.C. §103(a) based on Wimler

in view of Gillespie and Hutton is not proper because the combination of Wimler, Gillespie, and Hutton does not include a key limitation of claim 23.

Claim 23 is patentable because it depends on claim 3, which is patentable. In addition, claim 23 includes the limitation that the fishing rod holder comprises a U-shaped trough. On page 1376 of the American Heritage Dictionary of the English Language, submitted as an attachment to the response dated December 10, 2003, the word "trough" is defined as "a long, narrow, shallow receptacle", or "a long, narrow depression". The bracket 142 in Hutton is not long compared to its width, nor is it narrow as compared to its length, nor is it a receptacle, in the sense usually associated with a trough. It simply is not a trough. There is no other element of Wimler, Gillespie, or Hutton that can be considered a trough. Thus, the combination of Wimler, Gillespie, and Hutton does not disclose a limitation of claim 23 and claim 23 is patentable. MPEP 2143.03; *In re Glass*, supra; *In re Saether*, supra; *Ex parte Petersen*, supra; and *In re Fine*, supra.

VIII. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP V

The Examiner's rejection of claims 25 and 41 under 35 U.S.C. §103(a) based on Wimler in view of Gillespie and Hutton is not proper because the combination of Wimler, Gillespie, and Hutton requires wholesale modification of the references, does not include at least three key limitations of claim 25, and the insight of an integral fly box support and fishing rod holder is contrary to the teaching of the cited references.

Claim 25 includes the following limitations:

- an integrated fly box support and a fishing rod holder made of a single piece of rigid material, and including a base piece;

- a fastener adapted to releasably secure a pocket-sized fly box having an inside to said base piece so said inside of said fly box can be accessed without removing said fly box from said base piece and said fly box can be released from said base piece without using a tool;

- said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said inside of said fly box is being accessed; and

- a hinge for permitting movement of said fly box from a horizontal to a vertical position.

The Examiner has rejected this claim based on Wimler in view of Gillespie and Hutton. We have already seen in Section IIIA above that the combination of Wimler and Gillespie is not proper because it requires a wholesale modification of the references and a change in the principal of operation of Wimler. This argument is also applicable here because of the limitations relating to the fastener and the hinge. We also have seen in Section VI above that the combination of Wimler, Gillespie, and Hutton does not disclose or suggest a fishing rod holder configured to hold a fishing rod in a horizontal orientation. In addition, the only fishing rod holder is shown in Hutton, and this fishing rod holder 142 is not integrated with a fly box support, since the only fly box support in Hutton, i.e., the loops 302 and 304, are not integrated with the fishing rod holder 142. Further, the fly box supports 302 and 304 and the fishing rod holder 142 are not made of a single piece of rigid material. Thus, the argument of Section IIIB above is also applicable here. That is, since the combination of Wimler, Gillespie, and Hutton does not disclose nor suggest at least three claim limitations, claim 25 is patentable.

The features claimed in claim 25 eliminate breaks and connecting parts on which a fishing line can catch, and thus make for a more productive and enjoyable fishing experience. There is nothing in the three references that suggest such construction and advantages. This insight is contrary to the disclosures of Wimler, Gillespie, and Hutton, and in itself results in the patentability of claim 25. MPEP 2141.02 and *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). In the latter case, the issue was whether claims to an integral structure were patentable over the same structure made of four bolted pieces. The court found it was because this insight was not found in the prior art.

IX. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP VI

Claims 7 – 18 all depend on at least one patentable claim, namely claims 1, 3, and 6, and therefore are also patentable.

Claims 7 – 18 have been objected to as dependent on a rejected base claim. Since these claims all depend on a claim that is patentable as discussed above, these claims are

also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

X. ADDITIONAL ARGUMENT RELATING TO ALL REJECTED CLAIMS

In making his rejection of the claims under 35 U.S.C. §103(a), the Examiner is using the present application as a guide, and therefore his rejections are not proper.

It is apparent from the above that the Examiner is “taking a cue” from the specification and claims in making his rejections. In making his rejection over Wimler and Gillespie, the Examiner states that Wimler shows a chest fly box system, even though Wimler shows a tackle box attached to a person’s waist⁴. With respect to claims 1 and 25, he also states that the hinge in Wimler is “inherently releasable”, even though there is no evidence for this in Wimler. In the rejection of claims 1 and 2 over Volmer, the Examiner states that FIG. 9 of Volmer shows a chest fly box and base piece without pointing out which parts of Volmer’s FIG. 9 to which he is referring. In the rejections of claim 3, 6, 23, 25, and the other claims including the fishing rod holder, the Examiner sees a bracket 142 of Hutton as holding a fishing rod in a horizontal position, even though it clearly cannot do so. With respect to claims 21 and 25, he also sees the side of a tackle box as being a “fly box support”. With respect to claim 23, he sees the bracket 142 of Hutton as a “trough”. None of these “insights” are suggested by the references, but rather all are disclosed in the present specification and claims. Therefore, it is clear that the Examiner is doing what the Federal Circuit Court of Appeals strongly rejected in *W.L. Gore & Associates, Inc. v. Garlock* and many other cases:

The result is that the claims were used as a frame, and individual naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention. At no point did the district court, nor does Garlock, explain why that mosaic would have been obvious to one skilled in the art in 1969, or what there was in the prior art that would have caused those skilled in the art to disregard the teachings that were found against making just such a mosaic.

⁴ The American Heritage Dictionary of the English Language defines chest as “The part of the body between the neck and the abdomen, enclosed by the ribs and breastbone”. See the attachment to the response filed December 10, 2003. Clearly, the tackle box of Wimler is not attached to the chest of the fisherman.

* * *

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Associates, Inc. v. Garlock, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983). For this reason also, the rejections of claims 1 – 18, 23 – 25, 40, and 41 by the Examiner should be reversed by the Board.

XI. CONCLUSION

The law is clear that, in determining whether a claimed invention is patentable under 35 U.S.C. §103, the invention as a whole must be considered. MPEP 2141.02 and *Kimberly-Clark Corp. v. Johnson & Johnson*, 223 USPQ 603, 609 (Fed.Cir. 1984) at headnote 2. When the invention as a whole is considered, it is seen that Appellant has invented and claimed a unique system that has considerable advantages for fly fisherpersons. They can quickly adapt to a hatch rising from a stream by unfastening one fly box with one hand and substituting another, yet, when they wade out into a rushing, tree-shaded stream with the new flies, they know their new fly box is secure and out of reach of the elements. When they lose a fly, they can place their fishing rod in an out-of-the way position, and use two hands to quickly tie on a new fly even when they are waist-deep in a rapidly flowing stream. None of this was available with the prior art cited by the Examiner. Thus, we submit that the rejections of the Examiner should be reversed and claims 1 – 18, 23 – 25, 40, and 41 should be allowed. Appellant thanks the Board for its thoughtful consideration of this appeal.

Respectfully submitted,
PATTON BOGGS LLP

By: 

Carl A. Forest, Reg. No. 28,494
Telephone: (303) 894-6114
Facsimile: (303) 894-9239
Customer No.: 24283

9.) APPENDICES

APPENDIX A1 – CLAIMS WITH §112 AMENDMENTS

The following claims are pending on Appeal:

1. A chest fly box system for holding fishing equipment, comprising:
a base piece for supporting a pocket-sized fly box having an inside;
a harness that secures said base piece to the chest of a fisherman, with said base piece resting on the front of said chest;
a hinge for permitting movement of said fly box from a horizontal to a vertical position; and
a fastener adapted to releasably secure said pocket-sized fly box to said base piece so said inside of said fly box can be accessed without removing said fly box from said base piece;
wherein said fastener is adapted so that said fly box can be removed from said base piece without using a tool.
2. A chest fly box system as in claim 1, said fastener configured to secure a pocket-sized fly box to said base piece when the fly box is in a vertical closed position and when it is in a horizontal flat position.
3. A chest fly box system as in claim 1 and further including a fishing rod holder contiguous to said base piece and configured to hold a fishing rod in a horizontal orientation under a pocket-sized fly box supported on said base piece.
4. A chest fly box system as in claim 1, characterized in that said base piece comprises a vertical chest plate and a horizontal support plate, said vertical chest plate and said horizontal support plate forming a right angle, said chest plate having an upper edge, a lower edge, a chest-side surface and an outside surface, said support plate having an inner edge, an outer edge, a first side edge and a second side edge, a top surface, a bottom surface, a support plate width, and a support plate length, said inner edge contiguous with said lower edge of said chest plate, said support plate width and said support plate length being adequate to support a pocket-sized fly box in its vertical closed position.

5. A chest fly box system as in claim 4, further comprising a fishing rod holder, said fishing rod holder being attached to said base piece.

6. A chest fly box system as in claim 3, characterized in that said fishing rod holder comprises rigid construction material.

7. A chest fly box system as in claim 6, characterized in that said fishing rod holder comprises a U-shaped trough having a length and a width, said length determining a horizontal length direction, a first open end, a second open end opposite said first open end in said length direction, a proximate upper edge adjacent said base piece, and a distal upper edge opposite said proximate upper edge.

8. A chest fly box system as in claim 7, characterized in that said distal upper edge, said proximate upper edge and said outer edge of said support plate are in a single horizontal plane when said outer surface of said vertical chest plate is in a vertical plane.

9. A chest fly box system as in claim 8, characterized in that said outer edge of said support plate and said proximate upper edge of said fishing rod holder are formed by a bend in a single piece of construction material.

10. A chest fly box system as in claim 9, characterized in that said bend comprises a right angle.

11. A chest fly box system as in claim 10, further characterized by fasteners that secure a pocket-sized fly box to said base piece when the pocket-sized fly box is in a vertical closed position and when it is in a horizontal flat position.

12. A chest fly box system as in claim 11, characterized in that said harness is attached to said inner edge of said support plate and said upper edge of said chest plate.

13. A chest fly box system as in claim 12, characterized by a first slot between said outer edge and said proximate upper edge adjacent to said first open end, and by a second slot between said outer edge and said proximate upper edge adjacent to said second open end, and characterized in that said harness comprises flexible material and has a chest portion for covering said chest surface of said chest plate, said chest portion having a top region and a bottom, a sleeve portion at said top region that encloses said upper edge of said chest plate, a first finger at said bottom having a first flange, and a

second finger at said bottom having a second flange, said first finger located in said first slot and being secured by said first flange, and said second finger located in said second slot and being secured by said second flange.

14. A chest fly box system as in claim 13, characterized in that said sleeve portion, said first flange and said second flange comprise hook-and-loop fabric that attaches to corresponding pieces of hook-and-loop fabric on a pocket-sized fly box when said pocket-sized fly box is located in a vertical closed position on said support plate.

15. A chest fly box system as in claim 14, characterized in that said first flange and said second flange are rotatable 90 degrees about said outer edge of said support plate when a pocket-sized fly box to which said flanges are attached is rotated downward from a vertical closed position on said support plate to a horizontal flat position.

16. A chest fly box system as in claim 15, characterized in that said chest portion of said harness includes a pocket, said pocket having an opening at said top region.

17. A chest fly box system as in claim 16, characterized in that said harness further comprises: a first strap attached to said top region and having a female clip end, a second strap attached to said top region and having a male clip end, a first lateral tab attached to said bottom and having a male clip end, and a second lateral tab attached to said bottom and having a female clip end.

18. A chest fly box system as in claim 16, further comprising a pig-tail retractor attached to a side of said chest portion.

19. A chest fly box system as in claim 4, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said bottom surface of said support plate.

20. A chest fly box system as in claim 19, characterized in that said bottle holder comprises neoprene rubber tubing having an inside diameter of 2.5 cm.

21. A chest fly box system as in claim 1, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said base piece.

23. A chest fly box system as in claim 3, characterized in that said fishing rod

holder comprises a U-shaped trough.

24. A chest fly box system as in claim 3, characterized in that said fishing rod holder comprises a clamp.

25. A portable system for holding, storing and transporting fishing equipment, comprising:

an integrated fly box support and a fishing rod holder made of a single piece of rigid material, and including a base piece;

a fastener adapted to releasably secure a pocket-sized fly box having an inside to said base piece so said inside of said fly box can be accessed without removing said fly box from said base piece and said fly box can be released from said base piece without using a tool;

said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said inside of said fly box is being accessed; and

a hinge for permitting movement of said fly box from a horizontal to a vertical position.

40. A chest fly box as in claim 1 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

41. A chest fly box as in claim 25 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

APPENDIX A2 – CLAIMS WITHOUT §112 AMENDMENTS

The following shows the claims as they were prior to the amendment made on December 10, 2003 and the amendment filed with this brief.

1. A chest fly box system for holding fishing equipment, comprising:
a base piece for supporting a pocket-sized fly box;
a harness that secures said base piece to the chest of a fisherman, with said base piece resting on the front of said chest and covering less than 50% of said chest in a normal adult human;
a hinge for permitting movement of said fly box from a horizontal to a vertical position; and
a fastener adapted to releasably secure a pocket-sized fly box to said base piece so it can be accessed without removing it from said base piece;
wherein said fastener is adapted so that said fly box can be removed from said base piece without using a tool.
2. A chest fly box system as in claim 1, said fastener configured to secure a pocket-sized fly box to said base piece when the fly box is in a vertical closed position and when it is in a horizontal flat position.
3. A chest fly box system as in claim 1 and further including a fishing rod holder contiguous to said base piece and configured to hold a fishing rod in a horizontal orientation under a pocket-sized fly box supported on said base piece.
4. A chest fly box system as in claim 1, characterized in that said base piece comprises a vertical chest plate and a horizontal support plate, said vertical chest plate and said horizontal support plate forming a right angle, said chest plate having an upper edge, a lower edge, a chest-side surface and an outside surface, said support plate having an inner edge, an outer edge, a first side edge and a second side edge, a top surface, a bottom surface, a support plate width, and a support plate length, said inner edge contiguous with said lower edge of said chest plate, said support plate width and said support plate length being adequate to support a pocket-sized fly box in its vertical closed position.

5. A chest fly box system as in claim 4, further comprising a fishing rod holder, said fishing rod holder being attached to said base piece.

6. A chest fly box system as in claim 3, characterized in that said fishing rod holder comprises rigid construction material.

7. A chest fly box system as in claim 6, characterized in that said fishing rod holder comprises a U-shaped trough having a length and a width, said length determining a horizontal length direction, a first open end, a second open end opposite said first open end in said length direction, a proximate upper edge adjacent said base piece, and a distal upper edge opposite said proximate upper edge.

8. A chest fly box system as in claim 7, characterized in that said distal upper edge, said proximate upper edge and said outer edge of said support plate are in a single horizontal plane when said outer surface of said vertical chest plate is in a vertical plane.

9. A chest fly box system as in claim 8, characterized in that said outer edge of said support plate and said proximate upper edge of said fishing rod holder are formed by a bend in a single piece of construction material.

10. A chest fly box system as in claim 9, characterized in that said bend comprises a right angle.

11. A chest fly box system as in claim 10, further characterized by fasteners that secure a pocket-sized fly box to said base piece when the pocket-sized fly box is in a vertical closed position and when it is in a horizontal flat position.

12. A chest fly box system as in claim 11, characterized in that said harness is attached to said inner edge of said support plate and said upper edge of said chest plate.

13. A chest fly box system as in claim 12, characterized by a first slot between said outer edge and said proximate upper edge adjacent to said first open end, and by a second slot between said outer edge and said proximate upper edge adjacent to said second open end, and characterized in that said harness comprises flexible material and has a chest portion for covering said chest surface of said chest plate, said chest portion having a top region and a bottom, a sleeve portion at said top region that encloses said upper edge of said chest plate, a first finger at said bottom having a first flange, and a

second finger at said bottom having a second flange, said first finger located in said first slot and being secured by said first flange, and said second finger located in said second slot and being secured by said second flange.

14. A chest fly box system as in claim 13, characterized in that said sleeve portion, said first flange and said second flange comprise hook-and-loop fabric that attaches to corresponding pieces of hook-and-loop fabric on a pocket-sized fly box when said pocket-sized fly box is located in a vertical closed position on said support plate.

15. A chest fly box system as in claim 14, characterized in that said first flange and said second flange are rotatable 90 degrees about said outer edge of said support plate when a pocket-sized fly box to which said flanges are attached is rotated downward from a vertical closed position on said support plate to a horizontal flat position.

16. A chest fly box system as in claim 15, characterized in that said chest portion of said harness includes a pocket, said pocket having an opening at said top region.

17. A chest fly box system as in claim 16, characterized in that said harness further comprises: a first strap attached to said top region and having a female clip end, a second strap attached to said top region and having a male clip end, a first lateral tab attached to said bottom and having a male clip end, and a second lateral tab attached to said bottom and having a female clip end.

18. A chest fly box system as in claim 16, further comprising a pig-tail retractor attached to a side of said chest portion.

19. A chest fly box system as in claim 4, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said bottom surface of said support plate.

20. A chest fly box system as in claim 19, characterized in that said bottle holder comprises neoprene rubber tubing having an inside diameter of 2.5 cm.

21. A chest fly box system as in claim 1, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said base piece.

23. A chest fly box system as in claim 1, characterized in that said fishing rod

holder comprises a U-shaped trough.

24. A chest fly box system as in claim 1, characterized in that said fishing rod holder comprises a clamp.

25. A portable system for holding, storing and transporting fishing equipment, comprising:

an integrated fly box support and a fishing rod holder made of a single piece of rigid material, said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said fly box is being accessed;

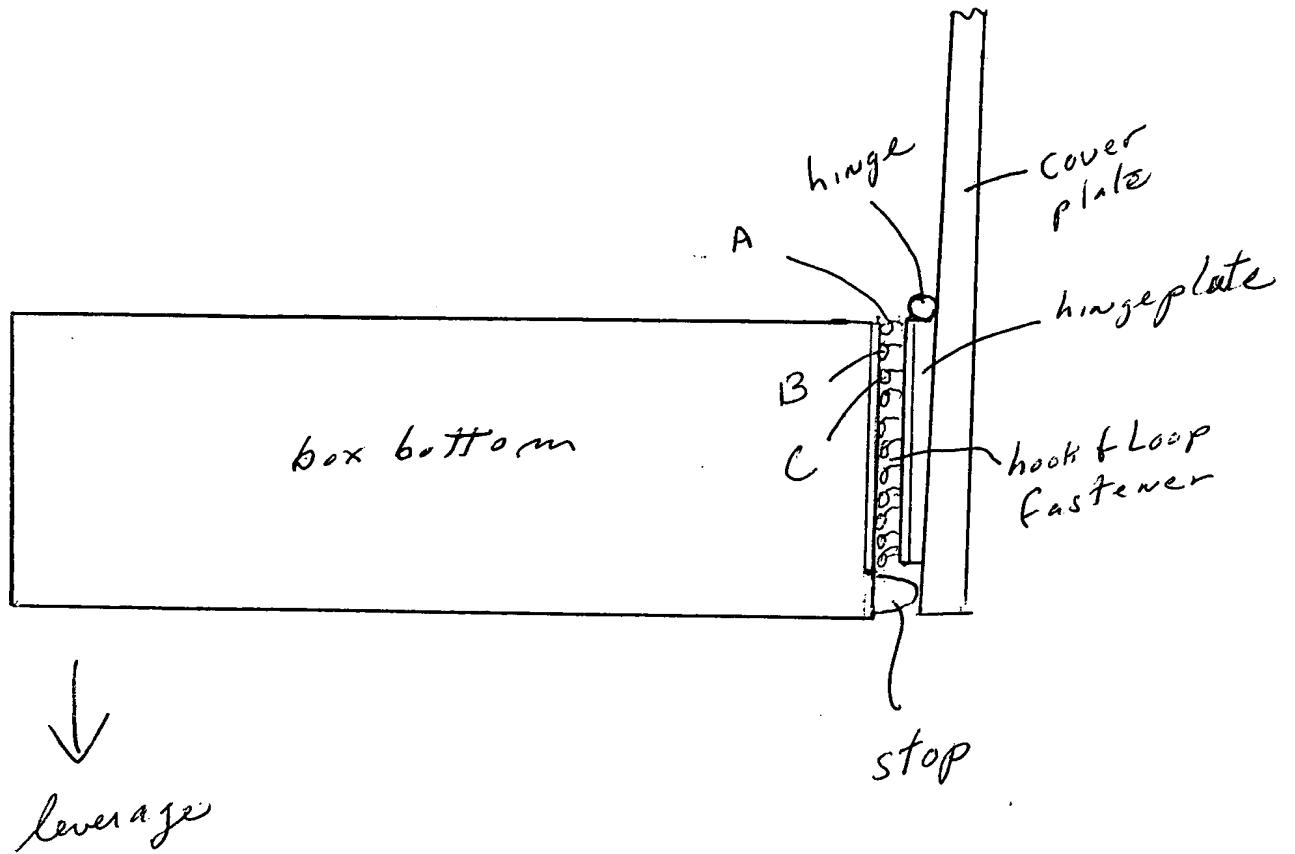
a fastener adapted to releasably secure a fly box to said base piece so it can be accessed without removing it from said base piece and released from said base piece without using a tool; and

a hinge for permitting movement of said fly box from a horizontal to a vertical position.

40. A chest fly box as in claim 1 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

41. A chest fly box as in claim 25 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

APPENDIX B



APPENDIX B



**THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application Serial No. 09/636,731)	Group Art Unit: 3643
)	
Filing Date: August 10, 2000)	Examiner: Rowan, Kurt C.
)	
For: Chest Fly Box System)	Docket No.: 013174.0101PTUS
)	(Formerly 9283/001)
Inventor: Jerry Moore)	
)	Confirmation No.: 9120
)	
)	Paper No.: 21

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence, along with all papers referred to as being enclosed or attached, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

February 12, 2004
Date

Elaine C. VonSpreckelsen
Elaine C. VonSpreckelsen

**MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Sir:

APPELLANT'S APPEAL BRIEF

Appellant herewith files his Brief in support of his Appeal in the above-identified matter.

This Appeal Brief is timely filed pursuant to 37 C.F.R. §1.192 because it is filed within three months of December 10, 2003, which is the date on which Appellant filed his Notice of Appeal, and a request and fee for a one-month extension of time are enclosed.

Appellant hereby authorizes the Commissioner to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR §1.136(a) for its timely submission, as incorporating a petition for extension of the appropriate length of time, and to charge any additional costs for such extension to Deposit Account No. 50-1848.

1.) REAL PARTY IN INTEREST

The real party of interest is the inventor, Jerry Moore. A product covered by the claims is currently being sold by Flyte Deck, Inc., a Colorado corporation wholly owned by Mr. Moore.

2.) RELATED APPEALS AND INTERFERENCES

None.

3.) STATUS OF CLAIMS

Claims 1 – 21, 23 – 25, 40, and 41 are pending on appeal. Claims 19 – 21 are withdrawn from consideration. Claims 1 – 6, 23 – 25, 40, and 41 stand rejected under 35 U.S.C. 103(a). Claims 7 – 18 are objected to as being dependent on a rejected base claim, but are indicated to be allowable if rewritten in independent form.

The history of the claim amendments is as follows. Claims 1 – 39 were filed in the initial application. On November 21, 2001, Appellant canceled claims 22 and 26 – 39 in response to a restriction requirement dated October 23, 2001. At the same time, claims 19 – 21 were withdrawn from consideration as a non-elected species. These claims will be reinstated if a generic claim is found to be patentable. In an amendment filed March 26, 2002 in response to an Office Action dated December 26, 2001, claims 1 and 25 were amended. These claims were further amended in an amendment filed June 17, 2002 in response to an Office Action dated May 6, 2002, and again amended in an amendment filed with an RCE on August 6, 2002 in response to an Office Action dated June 28, 2002. In an amendment filed February 6, 2003 in response to an Office Action dated November 6, 2002, Appellant again amended claims 1 and 25, as well as amended claims 23 and 24, and added new claims 40 and 41. In an amendment filed with a second RCE on July 22, 2003 in response to an Office Action dated April 23, 2003, Appellant further amended claims 1 and 25 and also amended claim 3. On December 10, 2003, Appellant made a final non-substantive amendment to claims 1 and 25 in a response to 35 USC §112 rejections in an Office Action dated September 10, 2003. A formal amendment to claims

23 and 24 to correct an antecedent/dependency problem discovered while preparing the Appeal Brief is submitted with this brief.

4.) STATUS OF AMENDMENTS

The Examiner has not provided an Advisory Action indicating that the amendment filed on December 10, 2003 with the Notice of Appeal will be entered. Of course, the amendment filed with this Appeal Brief has not been entered. However, since all the amendments address informalities, and since the amendment filed on December 10, 2003 are straightforward responses to 35 CFR §112 rejections while the amendment filed with this Appeal Brief are obvious corrections of an antecedent/ dependency problem, we will assume that these amendments will be entered. The Appendix includes copies of the claims with and without the 35 CFR §112 amendments.

5.) SUMMARY OF THE INVENTION

The invention is a chest fly box system 100. A chest fly box is a fly box used by fly fishermen. It is attached to the fisherman with a harness so that it rests on the center of the chest. See Exhibit A attached to the response faxed to the USPTO on February 6, 2003 (hereinafter "Exhibit A"). A chest fly box generally has a thin dimension and two relatively longer dimensions. In its stored position, it lies flat against the chest, with its thin dimension extending out from the chest just a few inches. This position prevents the fly box from getting wet as the fly fisherman wades into a stream or lake, and also prevents it from interfering with the fly fishing casting motion. See Exhibit A and page 1, lines 31 – 32¹. The chest fly box of the prior art includes at least one tray or other storage compartment that can be rotated ninety degrees down from the chest so it extends horizontally outward from the chest and is accessible. See Exhibit A and page 1, line 32 – page 2, line 8.

¹ Page and line numbers in this Appeal Brief refer to the specification of the present application, unless indicated otherwise.

Typically, a fly fisherman will adjust his or her lures, flies, and/or hooks to accommodate a wide variety of fish and fishing conditions. This may occur many times a day depending on changing fish feeding conditions, the type of fish, etc. In prior art chest fly boxes, this required a complicated, cumbersome process of changing trays. In addition, a fisherman with a chest fly box was restricted to trays made by the manufacturer of the particular fly box. See page 2, line 9 through page 3, line 5. The chest fly box system 100 according to the invention includes: a pocket-sized fly box 400 (FIGS. 1, 4, and 8; page 3, line 28; page 7, lines 21 – 25; page 12, lines 14 – 20; claim 1, lines 1 – 3); a base piece 202 for supporting the pocket-sized fly box (FIG. 2; page 3, line 28; page 7, line 24; page 8, line 27 – page 9, line 14; claim 1, line 3); a harness 300 that secures the base piece 202 to the chest of a fisherman, with the base piece 202 resting on the front of the chest (FIGS. 1 and 3; page 3, lines 28 and 29; page 11, line 22 – page 12, line 14; page 13, line 30 – page 14, line 8; claim 1, lines 4 and 5); and a hinge 322, 324 for permitting movement of the fly box 400 from a horizontal to a vertical position (FIGS. 8 and 9; page 6, lines 13 and 27; page 12, lines 23 – 25; page 13, lines 14 – 17; page 14, lines 27 – 29; page 15, lines 3 – 5; claim 1, lines 6 and 7). The chest fly box system 100 also includes a fastener 322a, 324a, 322b, 324b adapted to releasably secure the fly box 400 to the base piece 202 so the inside of the fly box can be accessed without removing the fly box from the base piece; the fastener is adapted so that the fly box 400 can be removed from the base piece 202 without using a tool. (See FIGS. 3, 4, 8, and 9; page 3, lines 29 and 30; page 4, lines 5 – 10; page 6, lines 23 – 27; page 13, lines 1 – 23; page 14, line 24 – page 15, line 6; claim 1, lines 8 – 12). This system 100 allows the fly fisherman to quickly and easily change his lures, flies, hooks, etc., while still keeping the fly box 400 secure and dry during fishing under the trying conditions often faced by fly fishermen, and retaining the other advantages of a chest fly box system. It also permits a variety of different fly boxes 400 to be used with the system 100. See page 13, lines 1 – 23.

The invention also includes a fishing rod holder 204 which is contiguous to the base piece 202 and is configured to hold a fishing rod 610 in a horizontal orientation under the pocket-sized fly box 400. See FIGS. 1, 2, 8, and 9; page 4, lines 11 – 23; page 7, lines 25

– 27; page 9, line 15 – page 10, line 17; and claim 3. This allows the fishing rod 610 to be secured in a position and location where it will not interfere with operations such as tying a fly and unhooking a fish. It also prevents it from catching on overhanging tree branches. The fishing rod holder 204 preferably comprises a U-shaped trough 240. *Ibid.*, particularly page 4, line 17; page 9, lines 25 and 26; claim 23. The fishing rod holder 204 is integrally formed with the fly box support 202, the two made of a single piece of rigid material. See FIG. 2; page 4, lines 20 – 30; page 5, lines 7 – 9; page 10, lines 10 – 14; claim 25, lines 3 and 4. The base piece 202 includes a fly box support plate 208. The support plate 208 and the upper edges 248 and 252 of the trough 240 are in a horizontal plane, so that they cooperate to provide support to the fly box 400 when it is in the opened, horizontal position. See FIGS. 2 and 9; page 5, lines 2 – 7; page 10, lines 5 – 10.

6.) ISSUES

The issues on appeal are:

1. Whether claims 1, 2, 4, and 40 are obvious under 35 U.S.C. 103(a) based on Wimler (US 1,549,400) in view of Gillespie (US 4,831,772).
2. Whether claims 1 and 2 are obvious under 35 U.S.C. 103(a) based on Volmer (US 5,950,352).
3. Whether claims 3, 5, 6, 23 – 25, and 41 are obvious under 35 USC 103 (b) based on Wimler in view of Gillespie and Hutton (US 5,505,354).

7.) GROUPING OF CLAIMS

Group I consists of claims 1, 2, and 40.

Group II consists of claim 4 and 5. These claims are separately patentable from the claims of the other groups because they include the limitation that the base piece includes a horizontal support plate.

Group III consists of claims 3, 6, and 24. These claims are separately patentable from the claims of the other groups because they include the limitation of a fishing rod holder contiguous to said base piece and configured to hold a fishing rod in a horizontal

orientation under a pocket-sized fly box supported on said base piece.

Group IV consists of claim 23. This claim is separately patentable from the claims of the other groups because it includes the limitation that the fishing rod holder comprises a U-shaped trough.

Group V consists of claims 25 and 41. These claims are separately patentable from the claims of the other groups because in combination with the base piece, fastener, and hinge as recited in claim 1, they include the following limitations: an integrated fly box support and a fishing rod holder made of a single piece of rigid material, and the fishing rod holder configured to hold a fishing rod in a horizontal orientation while the inside of the fly box is being accessed.

Group VI consists of claims 7 – 18. These claims are separately patentable from the claims of the other groups because they have been indicated to be allowable by the Examiner if rewritten in independent form.

8.) ARGUMENT

I. INTRODUCTION

As defined in 37 CFR 1.192, subparagraphs 8(iii) and 8(v) are not relevant to the instant appeal and are therefore omitted. Since they have all been overcome by responsive amendments, and the only other Examiner's rejections were under 35 USC §112 first and second paragraphs and 35 U.S.C. §103, the entire argument herein relates to subparagraphs 8(i), 8(ii) and 8(iv) of 37 CFR 1.192. In this argument, we shall reply to the Office Action of September 10, 2003 (hereinafter "the Office Action"), since this Office Action states all the currently outstanding rejections in this application.

II. THE 35 U.S.C. §102 REJECTIONS OF THE EXAMINER

In the Office Action of September 10, 2003, the Examiner made two 35 U.S.C. §112 rejections. To eliminate the §112 issues and make the appeal simpler, each of these rejections were responded to by an appropriate amendment. The rejections and how they

are believed to be overcome are as follows.

Claims 1 – 18, 23, and 24 were rejected because claim 1 had the limitation that the base piece covered less than 50% of the chest in a normal adult human, which the Examiner believed was not described in the specification. This was not believed to be correct because such a base piece is shown in the drawings and the dimensions of the base piece are given in the specification. However, this limitation has been removed from claim 1 by amendment.

Claims 1 – 18, 23 – 25, 40, and 41 were rejected because the limitation “the inside of the fly box” in claim 1, line 10, and “the inside” in claim 25, line 5, had insufficient antecedent basis. The proper antecedent, i.e., a fly box “having an inside” has been provided in line 3 of claim 1 by amendment. In claim 25, it was necessary to move the limitation of the fastener to a position prior to the limitation of the fishing rod holder to provide the proper antecedent, i.e., “having an inside” after “the fly box”, so this has been done by amendment.

As mentioned above, when the Appeal Brief was being prepared, it was noted that claims 23 and 24 improperly depended on claim 1 which had no antecedent for “said fishing rod holder”. They have been amended to properly depend on claim 3, which includes the antecedent for “said fishing rod holder,” in an amendment filed with this Appeal Brief.

III. THE CITED PRIOR ART

A. United States Patent No. 1,549,400 Issued To Wimler

Wimler discloses a “fisherman’s cabinet” which is shown attached to the waist of a fisherman using a pair of straps 7 (FIGS. 1 and 2). The cabinet includes a bottom portion 9 and a cover or base portion 6 which is the portion attached to the fisherman’s waist. The bottom portion is attached to the cover portion with a hinge, which is not numbered but is shown as a small round cylinder at the bottom center of FIG. 4. See column 1, lines 34 – 40. The bottom portion is open-ended, and contains compartments 14, 15 for holding fishing items. See column 2, lines 59 – 70. When open, the bottom portion 9 is horizontal.

Stops 19 (FIG. 4) near the hinge or the bottom corners 20 (FIG. 2) of the cover limit downward movement of the bottom portion. See column 2, lines 79 – 89. The bottom portion can be moved from a horizontal to a vertical position via the hinge. When it is moved vertically, it is held in the vertical closed position with a hasp 8 which fits over loop 11. See column 1, line 29 – column 2, line 58. A pair of bait boxes 16 (FIGS. 1 – 4) are pivotally supported on opposite sides of the bottom portion 9 of the cabinet. See column 2, lines 71 – 79.

B. United States Patent No. 4,831,772 Issued To Gillespie

Gillespie discloses a fishing tackle box 12 that includes a large number of smaller containers 56 for holding individual items of fishing tackle. The tackle box 12 has various strips of Velcro™ 42 (FIGS. 1 and 3) and 82 (FIG. 4) attached to the bottom (FIG. 1), sides (FIG. 4), and to divider plates 44 (FIG. 3), referred to as a “first attachment means”. Each of the containers 56 also has attached strips of Velcro™ 86 (FIG. 5) referred to as a “second attachment means”. The Velcro™ holds the containers 56 in place in the tackle box to prevent them from moving or shifting. See column 5, lines 47 – 68.

Of particular relevance to the present invention is a modified individual container 56a (FIG. 6), which has a line slot 90 through which a line 92 can pass. This allows the fisherman to attach the lure to the line 92 without handling the lure so the fisherman is not exposed to the hooks. See column 4, lines 22 – 55. This container can be removably attached to a fishing rod (FIG. 8) using a third strip of Velcro™ 102 attached to the fishing rod, allowing the fisherman to detach and attach the line without being exposed to the lure hooks, and providing a convenient place to store the container 56a while fishing. See column 6, lines 19 – 44.

C. United States Patent No. 5,505,354 Issued To Hutton

Hutton discloses a fishing tackle box 100 designed to be attached to the fisherman's belt 302, 304. See column 5, lines 26 – 28. The preferred size of the tackle box 100 is 8 inches in length by 3.5 inches in width by 3 inches deep. See column 3, lines 31 – 33. The pertinence to the present invention is the fact that the box 100 has a fishing rod bracket 142 attached to the exterior surface of the box. See column 4, lines 8 – 11.

D. United States Patent No. 5,950,352 Issued To Volmer

Volmer discloses a fishing wallet 86 (FIG. 9) which can be hung around the user's neck and held against the user's chest. The wallet has Velcro™ strips 92 which are used to hold interchangeable plates 84 (FIGS. 5 and 6) which have pockets 94 for holding fly boxes 54. See column 8, lines 54 – 58. The wallet 86 also includes pockets 120 for holding leader line. See column 10, lines 22 – 25. The wallet can be folded along line 112, which the Examiner refers to as a hinge. See column 11, lines 32 – 36.

IV. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP I

A. The Examiner's rejection of claims 1, 2, and 40 under 35 U.S.C. §103(a) based on Wimler and Gillespie is not proper because the combination of Wimler and Gillespie would require a substantial reconstruction and design of the elements shown in the references, as well as a change in the basic principals of Wimler.

The facts of this portion of the appeal are on all fours with *In re Ratti*, 123 USPQ 349 (CCPA 1959). In *Ratti*, the Board took note of the common knowledge that resilient deformable materials are incompressible. Here, the Board can take note of the fact that the releasable fastener as shown in Gillespie would not work in Wimler without significant reconstruction. Appendix B attached hereto shows the combination of Wimler and Gillespie, with as little reconstruction as possible. In this sketch, the thickness of the hook and loop fastener is exaggerated with respect to the other parts to make it easier to discuss. To make this combination, some sort of hinge plate is required to be connected to the hinge so as to provide room for the Velcro™ to attach. This is already a modification that is not proper, but for sake of argument, we will continue. Wimler is an all-purpose tackle box that is designed to hold a wide variety of tackle, plus a couple of bait boxes. It is much heavier than the containers of Gillespie. Also, in the position that the containers are connected to the fishing line in Gillespie, essentially all the hook and loop fasteners of the Velcro™ strip will be equally supporting the container. However, in Wimler, the tackle box is required to extend outward from the cover plate a considerable distance. The leverage of the box in this position would put significantly more stress on the hook and loop fastener

“A” at the top of the Velcro™ strip. This would cause the hook and loop “A” to separate, putting more stress on hook and loop fastener “B”, which would in turn separate, putting more stress on hook and loop fastener “C”. As a result, the box bottom would pull away from the hinge plate and fall off. Most people have experienced such a failure of a hook and loop fastener, and anyone familiar with hook and loop fasteners would know this, and thus the Board can take note of it as the CCPA did in *Ratti*. See *Ratti*, at page 351, headnote 1.

The fact that the hood and loop fasteners of Gillespie would not support the tackle box of Wimler would be clear to anyone skilled in the art; thus, they would not combine Wimler and Gillespie.

One could overcome the above problem by, in addition to the hinge plate, putting support under the fly box bottom, using a Velcro™ design that supported the box in two directions, making the tackle box of Wimler significantly smaller and lighter, and eliminating the bait boxes of Wimler². These changes not only result in wholesale modification of the references, but also change the principal of operation of Wimler, since it is no longer an all-purpose tackle box. Thus, this combination is not a proper ground for rejection of the claims. See *Ratti*, p. 352, at headnote 2. These changes are not suggested in the references, but rather in the present application. Thus, no prima facie case of obviousness of claim 1 under 35 U.S.C. § 103(a) has been made by the Examiner. See MPEP 2142 and 2143.01. Since claims 2 and 40 depend on claim 1, they are also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

B. The Examiner's rejection of claims 1 and 2 under 35 U.S.C. §103(a) based on Volmer is not proper because two key limitations of claim 1 are missing from Volmer.

² The Examiner may argue that all these modifications are not shown in claim 1, and/or that they must be included in claim 1 as they are essential to the invention. That would not be correct because the combination recited in claim 1 has utility as claimed. In *Ratti*, all the modifications that were part of the invention were not together in a single claim, but various ones of the modifications were claimed separately in claims 1, 4, 7, and 10. See *Ratti*, page 351, column 2. The *Ratti* court held that once the appellant had taught how the combination could be done, others could make redesigns. See *Ratti*, page 352, second paragraph following footnote 2. This is the case here also. For example, the Appellant has designed a system that meets claim 1, but uses a snap swivel instead of Velcro™, and does not use a fishing rod holder to add support for the fly box.

On page 6 of the Office Action, the Examiner rejects claims 1 and 2 under 35 U.S.C. 103(a) because allegedly, "The patent to Volmer shows a chest fly box as shown in FIG. 9 which shows a base piece, a harness, a hinge 112, and a fastener 92."³ Claim 1 recites:

A chest fly box system for holding fishing equipment, comprising:
a base piece for supporting a pocket-sized fly box having an inside;
a harness that secures said base piece to the chest of a fisherman,
with said base piece resting on the front of said chest;
a hinge for permitting movement of said fly box from a horizontal to a
vertical position; and
a fastener adapted to releasably secure said pocket-sized fly box to
said base piece so said inside of said fly box can be accessed without
removing said fly box from said base piece;
wherein said fastener is adapted so that said fly box can be removed
from said base piece without using a tool.

Referring to the above claims and FIGS. 5, 6, and 9 of Volmer, the Examiner does not say whether he considers that pockets 120 in FIG. 9 or the fly boxes 54 in FIGS. 5 and 6. If it is the fly box, Volmer lacks an important limitation of the invention, that the fly boxes can be accessed without removing them from the base piece. In addition, the hinge 112 does not permit movement of the fly box from a horizontal to a vertical position, since the fly boxes in FIGS. 5 and 6 are always in the vertical position. Thus, the Volmer system does not exhibit the key useful advantage of providing access to the fly box while standing in a stream and at the same time allowing two hands free to grasp the fly and attach it to a line. Instead, the user has to use one hand to hold the fly box as he is accessing it, put the fly box away, and then attach the fly to the line. If the user changes his mind, he will have to repeat the action of removing the fly box, accessing it, and putting it back.

If the pocket 120 is the "fly box", then Volmer does not disclose either a fastener adapted to releasably secure said pocket-sized fly box to said base piece, nor does it show a fastener that is adapted so that said fly box can be removed from said base piece without

³ On page 6 of the Office Action, the Examiner suggests that the 35 U.S.C. 103(a) rejection is being made rather than a 35 U.S.C. 102 rejection because Volmer does not show that "the base piece covers less than 50% of the chest of in a normal adult human being". The foregoing limitation in quotation marks has been removed from the claim because it was rejected under 35 U.S.C. §112, and all §112 rejections have been overcome by amendments so as to simplify the issues on appeal. However, since all limitations in a claim are required to be identically disclosed in a reference for a §102 rejection, the argument herein also applies if this is converted to a §102 rejection.

using a tool. Again, a key advantage of the instant invention is not available, namely, that the fly box can be quickly interchanged with other fly boxes.

It is fundamental patent law that to establish a prima facie basis for obviousness, all claim limitations must be taught or suggested by the prior art. MPEP 2143.03. "It is error to ignore specific limitations distinguishing over the references." *In re Glass*, 176 USPQ 489, 491 (CCPA 1973). See also *In re Saether*, 181 USPQ 36, 39 (CCPA 1974) at headnote 1; *Ex parte Petersen*, 228 USPQ 217, 218 (PO Bd Pat App & Inter 1985) at headnote 1; and *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 3. Since in either interpretation of claim 1 two key limitations of the claim are missing in Volmer, Volmer cannot make the invention obvious. Since claim 2 depends on claim 1, it is also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

V. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP II

The Examiner's rejection of claims 4 and 5 under 35 U.S.C. §103(a) based on Wimler in view of Gillespie and Hutton is not proper for the reasons given in Section IV because the combination of Wimler and Gillespie does not include a key limitation of claim 4.

Claim 4 is patentable because it depends on claim 1. In addition, claim 4 includes the following limitations:

said base piece comprises a vertical chest plate and a horizontal support plate, said vertical chest plate and said horizontal support plate forming a right angle, said chest plate having an upper edge, a lower edge, a chest-side surface and an outside surface, said support plate having an inner edge, an outer edge, a first side edge and a second side edge, a top surface, a bottom surface, a support plate width, and a support plate length, said inner edge contiguous with said lower edge of said chest plate, said support plate width and said support plate length being adequate to support a pocket-sized fly box in its vertical closed position.

In rejecting this claim, the Examiner says: "In reference to claim 4, Wimler shows all of the dimensions recited." That's all. He does not point out where the horizontal support plate is in Wimler, nor how such a support plate supposedly meets any of the limitations.

Serial No. 09/636,731

Appeal Brief

Page 12

192585v2

This horizontal support plate is useful because it interacts with the fly box, fishing rod holder, and the fasteners to hold the fly box securely without undue stress on the fasteners. There is no horizontal support plate in Wimler nor Gillespie. Thus, since an important limitation of claim 4 is missing, Wimler and Gillespie cannot make claim 4 obvious. MPEP 2143.03. *In re Glass*, supra; *In re Saether*, supra; *Ex parte Petersen*, supra; and *In re Fine*, supra. Since claim 5 depends on claim 4, it is also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

VI. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP III

The Examiner's rejection of claims 3, 6, and 24 under 35 U.S.C. §103(a) based on Wimler in view of Gillespie and Hutton is not proper because the combination of Wimler, Gillespie, and Hutton does not include three key limitations of claim 3.

Claims 3, 6, and 24 are patentable for the reasons given in Section IV above because they depend on claim 1. In addition, they are also patentable because they contain the limitation of a fishing rod holder contiguous to the base piece and configured to hold a fishing rod in a horizontal orientation under a pocket-sized fly box supported on the base piece. The Examiner admits that Wimler and Gillespie do not show a fishing rod holder, but maintains that Hutton “shows a fishing rod holder 142 mounted on the fly box support 102 and being configured to hold the fishing rod in a horizontal position”. The Examiner does not even allege that the fishing rod holder 142 in Hutton holds the fishing rod under the pocket-sized fly box as claimed. In addition, the fishing rod holder of Hutton is not attached to a “fly box support” as alleged by the Examiner, nor does the fishing rod holder hold the fishing rod in a horizontal position. We will address these in reverse order.

The Examiner maintains that the bracket 142 of Hutton holds a fishing rod in a horizontal position. This is impossible. The tackle box housing 102 of Hutton is preferably 8 inches long and attached to a fisherman's waist. See the above summary of Hutton. Hutton does not explain how the bracket 142 is used to hold a fishing rod. If the rod is placed horizontally on the bracket 142, it will either pass through the fisherman's body, which is ridiculous, or it will fall off because it will project far out from the fisherman's body

and be unbalanced. Further, the small size of the bracket suggests that it is not contemplated that the rod will be balanced on it. Rather, the only way this bracket could hold a fishing rod is if it pivoted about its connection to the tackle box. It is likely that it does pivot; otherwise, it would stick out inconveniently from the tackle box. If it were raised and a fishing rod handle were placed through its loop, the weight of the fishing rod would make the bracket rotate downward and force the fishing rod handle against the side of the tackle box, holding it with friction. Thus, it is likely that the rod holder of Hutton holds the fishing rod in a vertical direction. In this direction, it would brush on overhanging trees along a stream and not be very useful to a fly fisherman. At any rate, it is clear that Hutton does not disclose that the bracket 142 can be used to hold a fishing rod in a horizontal direction. Thus, this limitation is missing from the combination of Hutton, Wimler, and Gillespie.

Claim 1 from which claim 3 depends, as well as the specification, make clear that the base piece (which the Examiner calls the “fly box support”) recited in claim 3 is not the same as the fly box. The closest things to a fly box support in Hutton are the loops 302, 304 (FIG. 3) which attach the tackle box to the belt. These loops are not contiguous to the fishing rod holder 142.

Finally, as mentioned above, the Examiner does not even allege that the fishing rod holder 142 in Hutton holds the fishing rod under the pocket-sized fly box as claimed. This is important because it places the fishing rod in a position where it does not interfere with tying a fly on to the line.

Thus, the combination of Wimler, Gillespie, and Hutton do not disclose three limitations of claim 3, and therefore claim 3 is patentable. MPEP 2143.03; *In re Glass*, supra; *In re Saether*, supra; *Ex parte Petersen*, supra; and *In re Fine*, supra. Since claims 6 and 24 depend on claim 3, they are also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

VII. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP IV

The Examiner's rejection of claim 23 under 35 U.S.C. §103(a) based on Wimler

in view of Gillespie and Hutton is not proper because the combination of Wimler, Gillespie, and Hutton does not include a key limitation of claim 23.

Claim 23 is patentable because it depends on claim 3, which is patentable. In addition, claim 23 includes the limitation that the fishing rod holder comprises a U-shaped trough. On page 1376 of the American Heritage Dictionary of the English Language, submitted as an attachment to the response dated December 10, 2003, the word "trough" is defined as "a long, narrow, shallow receptacle", or "a long, narrow depression". The bracket 142 in Hutton is not long compared to its width, nor is it narrow as compared to its length, nor is it a receptacle, in the sense usually associated with a trough. It simply is not a trough. There is no other element of Wimler, Gillespie, or Hutton that can be considered a trough. Thus, the combination of Wimler, Gillespie, and Hutton does not disclose a limitation of claim 23 and claim 23 is patentable. MPEP 2143.03; *In re Glass*, supra; *In re Saether*, supra; *Ex parte Petersen*, supra; and *In re Fine*, supra.

VIII. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP V

The Examiner's rejection of claims 25 and 41 under 35 U.S.C. §103(a) based on Wimler in view of Gillespie and Hutton is not proper because the combination of Wimler, Gillespie, and Hutton requires wholesale modification of the references, does not include at least three key limitations of claim 25, and the insight of an integral fly box support and fishing rod holder is contrary to the teaching of the cited references.

Claim 25 includes the following limitations:

- an integrated fly box support and a fishing rod holder made of a single piece of rigid material, and including a base piece;

- a fastener adapted to releasably secure a pocket-sized fly box having an inside to said base piece so said inside of said fly box can be accessed without removing said fly box from said base piece and said fly box can be released from said base piece without using a tool;

- said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said inside of said fly box is being accessed; and

- a hinge for permitting movement of said fly box from a horizontal to a vertical position.

The Examiner has rejected this claim based on Wimler in view of Gillespie and Hutton. We have already seen in Section IIIA above that the combination of Wimler and Gillespie is not proper because it requires a wholesale modification of the references and a change in the principal of operation of Wimler. This argument is also applicable here because of the limitations relating to the fastener and the hinge. We also have seen in Section VI above that the combination of Wimler, Gillespie, and Hutton does not disclose or suggest a fishing rod holder configured to hold a fishing rod in a horizontal orientation. In addition, the only fishing rod holder is shown in Hutton, and this fishing rod holder 142 is not integrated with a fly box support, since the only fly box support in Hutton, i.e., the loops 302 and 304, are not integrated with the fishing rod holder 142. Further, the fly box supports 302 and 304 and the fishing rod holder 142 are not made of a single piece of rigid material. Thus, the argument of Section IIIB above is also applicable here. That is, since the combination of Wimler, Gillespie, and Hutton does not disclose nor suggest at least three claim limitations, claim 25 is patentable.

The features claimed in claim 25 eliminate breaks and connecting parts on which a fishing line can catch, and thus make for a more productive and enjoyable fishing experience. There is nothing in the three references that suggest such construction and advantages. This insight is contrary to the disclosures of Wimler, Gillespie, and Hutton, and in itself results in the patentability of claim 25. MPEP 2141.02 and *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). In the latter case, the issue was whether claims to an integral structure were patentable over the same structure made of four bolted pieces. The court found it was because this insight was not found in the prior art.

IX. THE REJECTIONS OF THE EXAMINER TO THE CLAIMS OF GROUP VI

Claims 7 – 18 all depend on at least one patentable claim, namely claims 1, 3, and 6, and therefore are also patentable.

Claims 7 – 18 have been objected to as dependent on a rejected base claim. Since these claims all depend on a claim that is patentable as discussed above, these claims are

also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4 and MPEP 2143.03.

X. ADDITIONAL ARGUMENT RELATING TO ALL REJECTED CLAIMS

In making his rejection of the claims under 35 U.S.C. §103(a), the Examiner is using the present application as a guide, and therefore his rejections are not proper.

It is apparent from the above that the Examiner is “taking a cue” from the specification and claims in making his rejections. In making his rejection over Wimler and Gillespie, the Examiner states that Wimler shows a chest fly box system, even though Wimler shows a tackle box attached to a person’s waist⁴. With respect to claims 1 and 25, he also states that the hinge in Wimler is “inherently releasable”, even though there is no evidence for this in Wimler. In the rejection of claims 1 and 2 over Volmer, the Examiner states that FIG. 9 of Volmer shows a chest fly box and base piece without pointing out which parts of Volmer’s FIG. 9 to which he is referring. In the rejections of claim 3, 6, 23, 25, and the other claims including the fishing rod holder, the Examiner sees a bracket 142 of Hutton as holding a fishing rod in a horizontal position, even though it clearly cannot do so. With respect to claims 21 and 25, he also sees the side of a tackle box as being a “fly box support”. With respect to claim 23, he sees the bracket 142 of Hutton as a “trough”. None of these “insights” are suggested by the references, but rather all are disclosed in the present specification and claims. Therefore, it is clear that the Examiner is doing what the Federal Circuit Court of Appeals strongly rejected in *W.L. Gore & Associates, Inc. v. Garlock* and many other cases:

The result is that the claims were used as a frame, and individual naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention. At no point did the district court, nor does Garlock, explain why that mosaic would have been obvious to one skilled in the art in 1969, or what there was in the prior art that would have caused those skilled in the art to disregard the teachings that were found against making just such a mosaic.

⁴ The American Heritage Dictionary of the English Language defines chest as “The part of the body between the neck and the abdomen, enclosed by the ribs and breastbone”. See the attachment to the response filed December 10, 2003. Clearly, the tackle box of Wimler is not attached to the chest of the fisherman.

* * *

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Associates, Inc. v. Garlock, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983). For this reason also, the rejections of claims 1 – 18, 23 – 25, 40, and 41 by the Examiner should be reversed by the Board.

XI. CONCLUSION

The law is clear that, in determining whether a claimed invention is patentable under 35 U.S.C. §103, the invention as a whole must be considered. MPEP 2141.02 and *Kimberly-Clark Corp. v. Johnson & Johnson*, 223 USPQ 603, 609 (Fed.Cir. 1984) at headnote 2. When the invention as a whole is considered, it is seen that Appellant has invented and claimed a unique system that has considerable advantages for fly fisherpersons. They can quickly adapt to a hatch rising from a stream by unfastening one fly box with one hand and substituting another, yet, when they wade out into a rushing, tree-shaded stream with the new flies, they know their new fly box is secure and out of reach of the elements. When they lose a fly, they can place their fishing rod in an out-of-the way position, and use two hands to quickly tie on a new fly even when they are waist-deep in a rapidly flowing stream. None of this was available with the prior art cited by the Examiner. Thus, we submit that the rejections of the Examiner should be reversed and claims 1 – 18, 23 – 25, 40, and 41 should be allowed. Appellant thanks the Board for its thoughtful consideration of this appeal.

Respectfully submitted,
PATTON BOGGS LLP

By: 

Carl A. Forest, Reg. No. 28,494
Telephone: (303) 894-6114
Facsimile: (303) 894-9239
Customer No.: 24283

9.) APPENDICES

APPENDIX A1 – CLAIMS WITH §112 AMENDMENTS

The following claims are pending on Appeal:

1. A chest fly box system for holding fishing equipment, comprising:
a base piece for supporting a pocket-sized fly box having an inside;
a harness that secures said base piece to the chest of a fisherman, with said base piece resting on the front of said chest;
a hinge for permitting movement of said fly box from a horizontal to a vertical position; and
a fastener adapted to releasably secure said pocket-sized fly box to said base piece so said inside of said fly box can be accessed without removing said fly box from said base piece;
wherein said fastener is adapted so that said fly box can be removed from said base piece without using a tool.
2. A chest fly box system as in claim 1, said fastener configured to secure a pocket-sized fly box to said base piece when the fly box is in a vertical closed position and when it is in a horizontal flat position.
3. A chest fly box system as in claim 1 and further including a fishing rod holder contiguous to said base piece and configured to hold a fishing rod in a horizontal orientation under a pocket-sized fly box supported on said base piece.
4. A chest fly box system as in claim 1, characterized in that said base piece comprises a vertical chest plate and a horizontal support plate, said vertical chest plate and said horizontal support plate forming a right angle, said chest plate having an upper edge, a lower edge, a chest-side surface and an outside surface, said support plate having an inner edge, an outer edge, a first side edge and a second side edge, a top surface, a bottom surface, a support plate width, and a support plate length, said inner edge contiguous with said lower edge of said chest plate, said support plate width and said support plate length being adequate to support a pocket-sized fly box in its vertical closed position.

5. A chest fly box system as in claim 4, further comprising a fishing rod holder, said fishing rod holder being attached to said base piece.

6. A chest fly box system as in claim 3, characterized in that said fishing rod holder comprises rigid construction material.

7. A chest fly box system as in claim 6, characterized in that said fishing rod holder comprises a U-shaped trough having a length and a width, said length determining a horizontal length direction, a first open end, a second open end opposite said first open end in said length direction, a proximate upper edge adjacent said base piece, and a distal upper edge opposite said proximate upper edge.

8. A chest fly box system as in claim 7, characterized in that said distal upper edge, said proximate upper edge and said outer edge of said support plate are in a single horizontal plane when said outer surface of said vertical chest plate is in a vertical plane.

9. A chest fly box system as in claim 8, characterized in that said outer edge of said support plate and said proximate upper edge of said fishing rod holder are formed by a bend in a single piece of construction material.

10. A chest fly box system as in claim 9, characterized in that said bend comprises a right angle.

11. A chest fly box system as in claim 10, further characterized by fasteners that secure a pocket-sized fly box to said base piece when the pocket-sized fly box is in a vertical closed position and when it is in a horizontal flat position.

12. A chest fly box system as in claim 11, characterized in that said harness is attached to said inner edge of said support plate and said upper edge of said chest plate.

13. A chest fly box system as in claim 12, characterized by a first slot between said outer edge and said proximate upper edge adjacent to said first open end, and by a second slot between said outer edge and said proximate upper edge adjacent to said second open end, and characterized in that said harness comprises flexible material and has a chest portion for covering said chest surface of said chest plate, said chest portion having a top region and a bottom, a sleeve portion at said top region that encloses said upper edge of said chest plate, a first finger at said bottom having a first flange, and a

second finger at said bottom having a second flange, said first finger located in said first slot and being secured by said first flange, and said second finger located in said second slot and being secured by said second flange.

14. A chest fly box system as in claim 13, characterized in that said sleeve portion, said first flange and said second flange comprise hook-and-loop fabric that attaches to corresponding pieces of hook-and-loop fabric on a pocket-sized fly box when said pocket-sized fly box is located in a vertical closed position on said support plate.

15. A chest fly box system as in claim 14, characterized in that said first flange and said second flange are rotatable 90 degrees about said outer edge of said support plate when a pocket-sized fly box to which said flanges are attached is rotated downward from a vertical closed position on said support plate to a horizontal flat position.

16. A chest fly box system as in claim 15, characterized in that said chest portion of said harness includes a pocket, said pocket having an opening at said top region.

17. A chest fly box system as in claim 16, characterized in that said harness further comprises: a first strap attached to said top region and having a female clip end, a second strap attached to said top region and having a male clip end, a first lateral tab attached to said bottom and having a male clip end, and a second lateral tab attached to said bottom and having a female clip end.

18. A chest fly box system as in claim 16, further comprising a pig-tail retractor attached to a side of said chest portion.

19. A chest fly box system as in claim 4, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said bottom surface of said support plate.

20. A chest fly box system as in claim 19, characterized in that said bottle holder comprises neoprene rubber tubing having an inside diameter of 2.5 cm.

21. A chest fly box system as in claim 1, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said base piece.

23. A chest fly box system as in claim 3, characterized in that said fishing rod

holder comprises a U-shaped trough.

24. A chest fly box system as in claim 3, characterized in that said fishing rod holder comprises a clamp.

25. A portable system for holding, storing and transporting fishing equipment, comprising:

an integrated fly box support and a fishing rod holder made of a single piece of rigid material, and including a base piece;

a fastener adapted to releasably secure a pocket-sized fly box having an inside to said base piece so said inside of said fly box can be accessed without removing said fly box from said base piece and said fly box can be released from said base piece without using a tool;

said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said inside of said fly box is being accessed; and

a hinge for permitting movement of said fly box from a horizontal to a vertical position.

40. A chest fly box as in claim 1 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

41. A chest fly box as in claim 25 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

APPENDIX A2 – CLAIMS WITHOUT §112 AMENDMENTS

The following shows the claims as they were prior to the amendment made on December 10, 2003 and the amendment filed with this brief.

1. A chest fly box system for holding fishing equipment, comprising:
 - a base piece for supporting a pocket-sized fly box;
 - a harness that secures said base piece to the chest of a fisherman, with said base piece resting on the front of said chest and covering less than 50% of said chest in a normal adult human;
 - a hinge for permitting movement of said fly box from a horizontal to a vertical position; and
 - a fastener adapted to releasably secure a pocket-sized fly box to said base piece so it can be accessed without removing it from said base piece;
 - wherein said fastener is adapted so that said fly box can be removed from said base piece without using a tool.
2. A chest fly box system as in claim 1, said fastener configured to secure a pocket-sized fly box to said base piece when the fly box is in a vertical closed position and when it is in a horizontal flat position.
3. A chest fly box system as in claim 1 and further including a fishing rod holder contiguous to said base piece and configured to hold a fishing rod in a horizontal orientation under a pocket-sized fly box supported on said base piece.
4. A chest fly box system as in claim 1, characterized in that said base piece comprises a vertical chest plate and a horizontal support plate, said vertical chest plate and said horizontal support plate forming a right angle, said chest plate having an upper edge, a lower edge, a chest-side surface and an outside surface, said support plate having an inner edge, an outer edge, a first side edge and a second side edge, a top surface, a bottom surface, a support plate width, and a support plate length, said inner edge contiguous with said lower edge of said chest plate, said support plate width and said support plate length being adequate to support a pocket-sized fly box in its vertical closed position.

5. A chest fly box system as in claim 4, further comprising a fishing rod holder, said fishing rod holder being attached to said base piece.

6. A chest fly box system as in claim 3, characterized in that said fishing rod holder comprises rigid construction material.

7. A chest fly box system as in claim 6, characterized in that said fishing rod holder comprises a U-shaped trough having a length and a width, said length determining a horizontal length direction, a first open end, a second open end opposite said first open end in said length direction, a proximate upper edge adjacent said base piece, and a distal upper edge opposite said proximate upper edge.

8. A chest fly box system as in claim 7, characterized in that said distal upper edge, said proximate upper edge and said outer edge of said support plate are in a single horizontal plane when said outer surface of said vertical chest plate is in a vertical plane.

9. A chest fly box system as in claim 8, characterized in that said outer edge of said support plate and said proximate upper edge of said fishing rod holder are formed by a bend in a single piece of construction material.

10. A chest fly box system as in claim 9, characterized in that said bend comprises a right angle.

11. A chest fly box system as in claim 10, further characterized by fasteners that secure a pocket-sized fly box to said base piece when the pocket-sized fly box is in a vertical closed position and when it is in a horizontal flat position.

12. A chest fly box system as in claim 11, characterized in that said harness is attached to said inner edge of said support plate and said upper edge of said chest plate.

13. A chest fly box system as in claim 12, characterized by a first slot between said outer edge and said proximate upper edge adjacent to said first open end, and by a second slot between said outer edge and said proximate upper edge adjacent to said second open end, and characterized in that said harness comprises flexible material and has a chest portion for covering said chest surface of said chest plate, said chest portion having a top region and a bottom, a sleeve portion at said top region that encloses said upper edge of said chest plate, a first finger at said bottom having a first flange, and a

second finger at said bottom having a second flange, said first finger located in said first slot and being secured by said first flange, and said second finger located in said second slot and being secured by said second flange.

14. A chest fly box system as in claim 13, characterized in that said sleeve portion, said first flange and said second flange comprise hook-and-loop fabric that attaches to corresponding pieces of hook-and-loop fabric on a pocket-sized fly box when said pocket-sized fly box is located in a vertical closed position on said support plate.

15. A chest fly box system as in claim 14, characterized in that said first flange and said second flange are rotatable 90 degrees about said outer edge of said support plate when a pocket-sized fly box to which said flanges are attached is rotated downward from a vertical closed position on said support plate to a horizontal flat position.

16. A chest fly box system as in claim 15, characterized in that said chest portion of said harness includes a pocket, said pocket having an opening at said top region.

17. A chest fly box system as in claim 16, characterized in that said harness further comprises: a first strap attached to said top region and having a female clip end, a second strap attached to said top region and having a male clip end, a first lateral tab attached to said bottom and having a male clip end, and a second lateral tab attached to said bottom and having a female clip end.

18. A chest fly box system as in claim 16, further comprising a pig-tail retractor attached to a side of said chest portion.

19. A chest fly box system as in claim 4, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said bottom surface of said support plate.

20. A chest fly box system as in claim 19, characterized in that said bottle holder comprises neoprene rubber tubing having an inside diameter of 2.5 cm.

21. A chest fly box system as in claim 1, further comprising:
a bottle holder for holding a bottle in a horizontal position, said bottle holder attached to said base piece.

23. A chest fly box system as in claim 1, characterized in that said fishing rod

holder comprises a U-shaped trough.

24. A chest fly box system as in claim 1, characterized in that said fishing rod holder comprises a clamp.

25. A portable system for holding, storing and transporting fishing equipment, comprising:

an integrated fly box support and a fishing rod holder made of a single piece of rigid material, said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said fly box is being accessed;

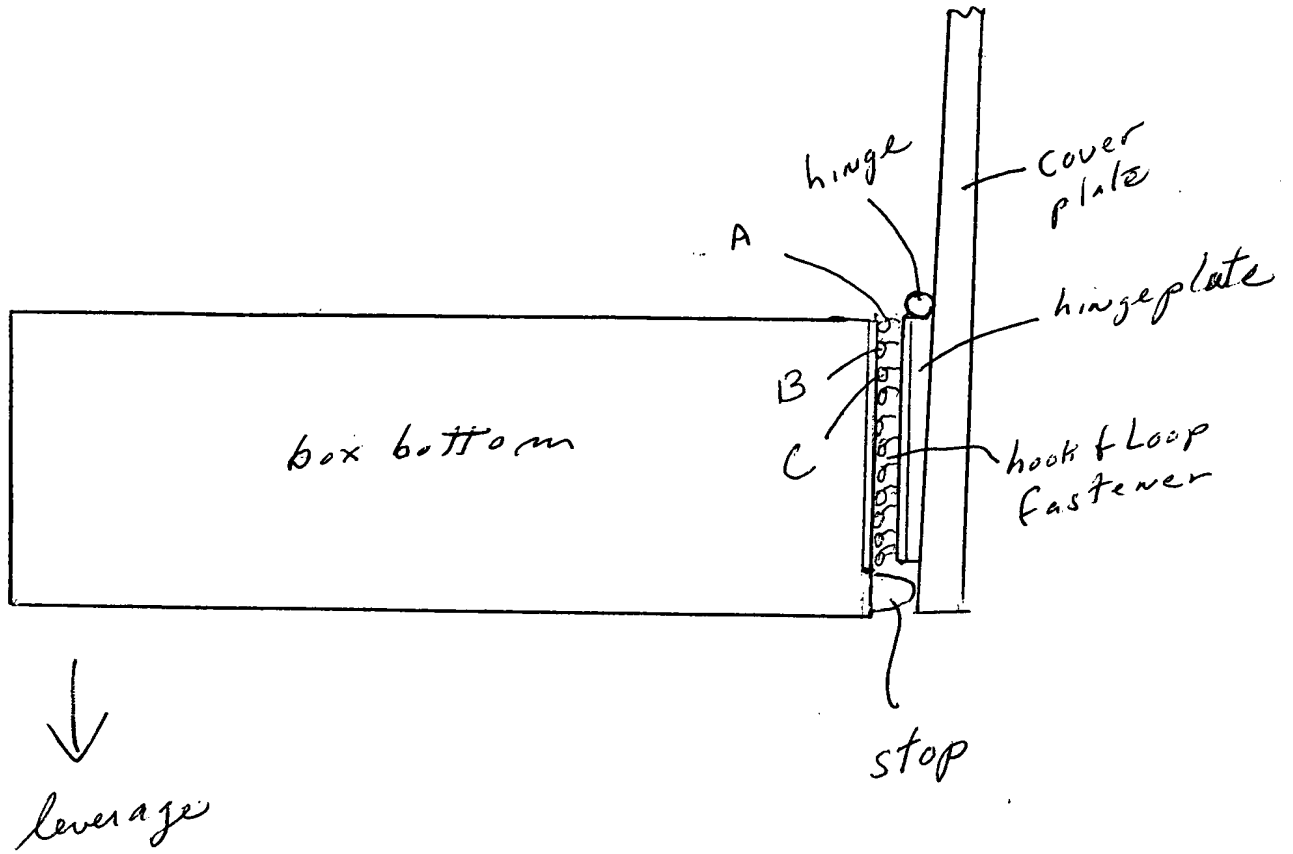
a fastener adapted to releasably secure a fly box to said base piece so it can be accessed without removing it from said base piece and released from said base piece without using a tool; and

a hinge for permitting movement of said fly box from a horizontal to a vertical position.

40. A chest fly box as in claim 1 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

41. A chest fly box as in claim 25 wherein said fastener is further adapted so that said fly box can be released from said base piece while all parts of said fastener remain attached to either said fly box or said base piece.

APPENDIX B



APPENDIX B